

DOCKET NO: 296895US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
FRANK-MARTIN PETRAT, ET AL. :
SERIAL NO: 10/594,995 : ATTN: LICENSING AND REVIEW
FILED: JULY 26, 2007 :
FOR: NANOSCALAR SILICON :
PARTICLES IN NEGATIVE ELECTRODE
MATERIALS FOR USE IN LITHIUM-ION
BATTERIES

PETITION FOR A RETROACTIVE FOREIGN
FILING LICENSE UNDER 37 C.F.R. § 5.25

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The undersigned Petitioners hereby respectfully request a retroactive foreign filing license under 35 U.S.C. § 184 and pursuant to 37 C.F.R. § 5.25. The license is sought for the subject matter disclosed in the above-identified U.S. patent application 10/594,995, filed on July 26, 2007, by Dr. Frank-Martin PETRAT, et al, entitled “Nanoscalar Silicon Particles In Negative Electrode Materials For Use In Lithium-Ion Batteries,” which is a 35 U.S.C. § 371 National Stage patent application of international patent application PCT/EP2005/051238, which was filed on March 17, 2005 in the receiving office of the International Bureau of the World Intellectually Property Organization, which claims priority to German patent application DE 102004016766.4-45, which was filed on April 1, 2004 in the German Patent Office.

The subject matter disclosed in the above-identified U.S. patent application was filed in the following countries on the dates specified:

Country and/or Receiving Office	Filing Date
Germany	April 1, 2004
China	November 30, 2006
Europe	March 17, 2005
International Bureau of the WIPO	March 17, 2005
Japan	October 2, 2006
Taiwan	March 31, 2005
India	September 28, 2006
South Korea	September 29, 2006
United States	July 26, 2007

The above-identified receiving offices are the only national and international receiving offices in which the subject matter disclosed in the above-identified U.S. patent application has previously been filed.

Pursuant to 37 C.F.R. §§ 5.14(a) and 5.25(a), since there is a U.S. patent application on file, copies of the corresponding non-U.S. patent applications are not required, as the subject matter to be licensed will be measured by the disclosure of the U.S. patent application.

Dr. Olbricht is patent counsel in the Intellectual Property Department of Evonik Industries AG (Evonik Degussa GmbH until July 31, 2011), located in Marl, Germany. Dr. Gerhard Olbricht is the supervisor of in-house patent counsel responsible for directing the filing of the subject matter disclosed in the above-identified U.S. patent application in the above-identified receiving offices.

Attached hereto is the Declaration of Dr. Olbricht, which contains the information required under 37 C.F.R. § 5.25(a)(3). As averred to in the attached declaration, the subject matter disclosed in the above-identified U.S. patent application was neither under a secrecy order at the time that it was filed abroad, nor currently under a secrecy order.

As explained in the attached declaration, in-house patent counsel for Evonik Degussa GmbH were unaware at the time of filing the patent application in Germany, China, Europe, India, Japan, Taiwan, the International Bureau of the WIPO, and South Korea that David Lee may have contributed to at least part of the claimed subject matter of this application while present in the U.S. since the inventorship had not yet been determined prior to filing in the above-identified foreign countries. The inventorship information was not needed at the time of filing in these foreign countries.

Upon discovering on July 13, 2011, that a researcher may have contributed to at least part of the claimed subject matter of this application while present in the U.S., as well as becoming privy to how the requirements set forth in 35 U.S.C. § 184 and 37 C.F.R. § 5.25 may apply to this case, Dr. Olbricht's colleague Dr. Geipel within the Intellectual Property Department of Evonik Degussa GmbH immediately instructed the undersigned Petitioners on July 14, 2011 to request a retroactive foreign filing license, thereby evidencing diligence in the procurement of a retroactive foreign filing license. Further investigation of this matter has resulted in the present request for a retroactive foreign filing license.

In view of the foregoing discussion and the attached Declaration, the above-identified non-U.S. patent applications were filed in the above-mentioned receiving offices through error and without deceptive intent. This is evidenced by the fact that Evonik Degussa GmbH was simply unaware at the time of filing that a researcher may have contributed to at least part of the claimed subject matter of this application while present in the U.S. It should also be mentioned that because Dr. Olbricht is a German National, he is not entirely familiar with U.S. patent law and U.S. patent practice and procedure.

As a result, Applicants are now diligently seeking a retroactive foreign filing license and include herewith the required fee under 37 C.F.R. § 1.17(g).

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Petition under 37 C.F.R. § 5.25

Consequently, it is respectfully requested that this petition be GRANTED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.

A handwritten signature in black ink, appearing to read 'Kirsten A. Grüneberg', written over a horizontal line.

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